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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,482	06/19/2000	ROBERT J. WATTS	DYC-011	7997

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EXAMINER

HAMILTON, LALITA M

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 04/22/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/529,482

Applicant(s)

WATTS, ROBERT J.

Examiner

Lalita M Hamilton

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 28-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Prosecution Application

The request filed on February 13, 2003 for a Continued Prosecution Application (CPA) has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In the specification, there is no support for first and second tubular portions, stiffness of reinforcing means being greater than first and second tubular portions, thickness of the first and second tubular portions, or second flexural stiffness greater than the first flexural stiffness.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

In response to the amendment, the rejections set forth in paper no.6 have been withdrawn.

Claims 1-20 and 28-32 are rejected under 35 U.S.C. second paragraph.

In claim 1, there is no support for first and second tubular portions.

In claim 10, there is no support for the stiffness of the reinforcing means being greater than the first and second tubular portions.

Claims 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The insertion slit is not shown in the drawings.

In claims 29 and 32, there is no support for the thickness of the first and second tubular portions.

In claim 31, there is no support for the second flexural stiffness being greater than the first flexural stiffness.

Claims 2-9, 15-20, 28, and 30 are rejected for being dependent upon rejected claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-15, 17-20, and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall ('326) in view of Hill ('359).

Hall discloses a foot device comprising a first tubular portion (fig.1: 14 and 18), a closing means selectively operable to close an opening (26), a second tubular portion (36), first and second tubular portions integrally formed (28 and col.2, lines 48-51), reinforcing means being a plastic rib (10), a insertion slit, and an orthosis formed of injection molding (col.5, lines 25-30); however, Hall does not disclose first and second tubular portions formed of 35 shore silicone elastomer, a rib formed of polypropylene,

ortholene, and carbon fiber, reinforcing means having a stiffness greater than the first and second tubular portions, a zip fastener, eyelets, a skin colored orthosis, or an orthosis stamped or pressed from sheet material. Hill teaches a brace comprising a tubular portion formed of 35 shore silicone elastomer (col.3, lines 2-5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the 35 shore silicone elastomer taught by Hill as an alternative material for the first and second tubular portions and rib disclosed by Hall.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a rib formed of polypropylene, ortholene, or carbon fiber, since it has been held to be within the general skill of a worker in the art to select known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

It is inherent that the reinforcing means may have a stiffness greater than the first and second tubular portions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a reinforcing means having a stiffness greater than the first and second tubular portions so as to provide increased support and stability.

Hall discloses that they may be customized (col.5, lines 29-31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a zip fastener or eyelets as alternative means of securing the device about the user's limb, a skin colored orthosis to provide a more natural and appealing

appearance, and an orthosis stamped or pressed from sheet material as an alternative means of making the device.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall and Hill as applied to claims 1 and 2 above, and in further view of Arensdorf ('641).

Hall discloses and Hill teaches the invention substantially as claimed; however, neither reference discloses nor teaches a reinforcing means comprising a tape having a figure-8 configuration or the device enveloping a portion of the plantar aspect of the foot without enveloping the calcaneum. Arensdorf teaches a foot support comprising integrally formed first and second tubular portions having a tape forming a figure-8 under the foot (fig.5: 32, 34, 42, and 50) and the device enveloping a portion of the plantar aspect of the foot without enveloping the calcaneum (fig.4: 30). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a reinforcing means comprising a tape having a figure-8 configuration as an alternative reinforcement means and the device enveloping a portion of the plantar aspect of the foot without enveloping the calcaneum as an alternative embodiment of the device fitting the foot as disclosed and taught by Hall and Hill.

Conclusion

This is a CPA of applicant's earlier Application No. 09/529,482. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-6101 for regular communications and (703) 746-6101 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-

2272.


LMH

April 16, 2003


HANI M. KAZIMI
PRIMARY EXAMINER